

09/919,304
DP-304,879

1745
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Benson et al.

Serial No.: 09/919,304

Art Unit: 1745

Filed: 07/31/2001

Examiner: Alejandro, R.

For: BATTERY PACK HAVING FLEXIBLE CIRCUIT CONNECTOR

Docket No.: DP-304,879

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Dear Sir:

This paper is responsive to the Office Action mailed April 22, 2002 (Paper No. 5).

Applicants hereby elect, with traverse, the invention of Group I for prosecution on the merits (presently claims 1-17) drawn to a battery pack.

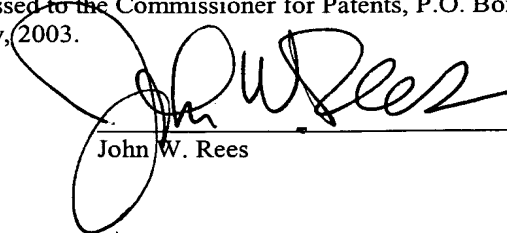
The Examiner has restricted the present application as follows:

Group I: claims 1-17; and

Group II: claims 18-21.

CERTIFICATE OF MAILING

I hereby certify that this *Response to Restriction Requirement* is being deposited with the United States Postal Service in an envelope as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of May, 2003.


John W. Rees

There are two criteria for proper restriction:

1. The inventions must be independent or distinct as claimed;
2. There must be a serious burden on the examiner if restriction is not required (MPEP § 803).

Accordingly, a restriction is proper only when the restricted inventions are independent and patentably distinct (MPEP § 803). Further, the burden is on the examiner to provide reasons and/or examples in support of restriction (MPEP § 803). The Office has not carried this burden.

The Office has asserted that the inventions are related as process of making and product made. As stated in the Office Action:

The inventions are distinct if either or both of the following can be shown: (1) that the process *as claimed* can be used to make other and materially different product or (2) that the product *as claimed* can be made by another and materially different process (MPEP § 806.05(f)). (emphasis added).

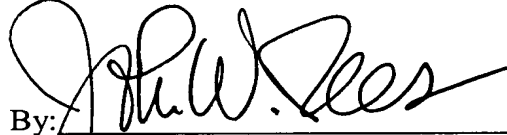
The Office has further stated in “the instant case, the process as claimed can be used to make other and materially different product, for example, to make a pack comprising capacitor devices.”

However, the process as claimed involves, among other things, “connecting said plurality of battery modules electrically via a flexible circuit . . .”. The battery pack, as claimed involves, among other things, “a plurality of battery modules each having at least one positive terminal and one negative terminal ...and a flexible circuit configured to connect said plurality ... terminals ...”. Applicants do not perceive how “a pack comprising capacitor devices” is a materially different product than a pack comprising “a plurality of battery modules.” The term “battery modules” does not preclude “capacitor devices”. Accordingly, Applicants respectfully submit that the example provided by the Office does not establish “a materially different product” from the process as claimed. Accordingly the Office has not established distinctiveness as required for restriction.

Applicants respectfully submit that the Office has thus not carried its burden of persuasion in establishing distinctness and respectfully request withdrawal of the restriction requirement.

Applicants respectfully submit that the restriction requirement set forth in Paper No. 5 is improper, and respectfully request that it be withdrawn.

Respectfully submitted,



By:

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